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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,277	06/19/2002	Bernd Berger	20496-323	8725

7590  
Proskauer Rose  
1585 Broadway  
New York, NY 10036

07/11/2003

EXAMINER

GOETZ, JOHN S

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/088,277

Applicant(s)

BERGER ET AL.

Examiner

John S. Goetz

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/19/202 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. The preliminary amendment contained two claims numbered "claim 18." This appears to be a typographical error. As a result, the second "claim 18" is presumed to be claim 20 and is treated as such in the Office action below.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. In claim 12, the use of two transitional phrases ("comprising" in line 2 and "comprising" in line 6) is needlessly confusing and renders the claim vague and indefinite.

5. Claims 19 and 20 refer to two "components" of the support beam but, confusingly, each claim only refers to one of these components by reference number. Claim 19 refers to "the first component (12a)" but does not give a reference number for "the second component." Similarly, claim 20 refers to "the second component (12b)" but does not give a reference number for "the first component." This confusing inconsistency renders the claims vague and indefinite.

6. Additionally, claim 20 recites the limitation "the first component" and "the second component." There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 12-16 and 18, as best understood, are rejected under 35 U.S.C. 102(b) as being clearly anticipated by EP 0 149 247 (hereinafter EP '247). EP '247 discloses a rolling stand with laterally supporting rolls that are retracted in order to facilitate replacement of the work rolls (see page 10, line 21 through page 11, line 5).

9. Applicant should note that functional phrases occurring in the claims have been given limited patentable weight. As for example, the “suggestive function” language of claim 12 (explained above) and the entire claim 13 attempt to describe the apparatus in terms of what the device does and not what it is. Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device *is*, not what a device *does*.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)(emphasis in original).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over EP '247. It would have been an obvious matter of design choice to provide a hydrostatic bearing arrangement since the applicant has not disclosed that using a hydrostatic bearing solves any stated problem or is for any particular purpose. Furthermore, it appears that the invention would perform equally well with a roller bearing.

12. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '247, alone or, alternatively, in view of Truxa (3,535,204). Claims 19 and 20, as best understood, add that the support beam is separated into two slidably detachable interconnected components.

13. First, it would have been obvious to one of ordinary skill in the art to separate the support beam in EP '247 into two separable parts, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177.

14. Alternatively, Truxa teaches, in the apposite art of joints and connections for machine parts, the securing of two elongated elements by the use of slidably detachable interconnected components via a well-know projection and groove type arrangement (Fig. 1 and 2). The Truxa invention is drawn to "a simplified method of mounting machine elements in a secured relation with one another" (column 1, lines 57-58). Furthermore, Truxa teaches that such a connection reduces machine downtime by facilitating a quick exchange of machine elements (column 3, lines 14-18). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to separate the support beam taught by EP '247 into two machine parts that are connected by a projection and groove (thus slidably detachable) in order to maintain a tight

Art Unit: 3725

secure connection of said parts while simultaneously facilitating quick removal when replacement is necessary, as suggested by Truxa.

*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kobayashi et al. (5,119,656) discloses a rolling stand with laterally supporting rolls that are retracted in order to facilitate replacement of the work rolls.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Goetz whose telephone number is 703-308-1411. The examiner can normally be reached on Mon, Tues, Thurs, Fri 7:00am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on 703-308-3136. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

17. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3136.

JSG  
July 8, 2003



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